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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,022	10/23/2000	Steven Z. Wu	M-8873 US	3060

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EXAMINER

PREBILIC, PAUL B

ART UNIT PAPER NUMBER

3738

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 09/695,022	Applicant(s) WU ET AL.	
	Examiner Paul B. Prebilic	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,8-11,21-25 and 27-47 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-33,42,44 and 47 is/are rejected.
- 7) ☒ Claim(s) 1,3,4,8-11,21-27,34-41,43,45 and 46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: <u>2005 0404</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In claim 1, line 5, "said string traversing at least two grooves" does not have support from the specification. In claim 28, lines 4-5 (underlined portion), claim 33, lines 4-8, and claim 47, lines 4-7, the language of these claims does not have clear antecedent support from the specification. In the case of claim 1, the Examiner suggest replacing the language with ---said string resting in a plurality of grooves--- in order to overcome this objection. In the case of claims 28, 33 and 47, the Examiner suggests inserting the language thereof into the specification where appropriate.

Claim Objections

Claims 1, 3, 4, 8-11, 21-25, and 27-47 are objected to because of the following informalities: In claim 1, line 5, "said string traversing at least two grooves" does not have antecedent support from the specification. In claim 28, lines 4-5 (underlined portion), claim 33, lines 4-8, and claim 47, lines 4-7, the language of these claims does not have clear antecedent support from the specification. In the case of claim 1, the Examiner suggest replacing the language with ---said string resting in a plurality of grooves--- in order to overcome this objection. In the case of claims 28, 33 and 47, the Examiner suggests inserting the language thereof into the specification where appropriate. The dependent claims 3, 4, 8-11, 21-25, 27, 29-32, 34-46 are objected to because they contain the objectionable language by incorporation.

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With regard to claims 1, 33, and 47, it is not clear whether the preambles are required for the claim bodies or whether the claim bodies can be read on by devices outside the art of the preambles. For this reason, the scopes of these claims are not considered clear. The Examiner suggests inserting the language ---of said implantable prosthesis--- after "body structure", (1) on line 3 of claim 1, (2) on line 5 of claim 33, and (3) on lines 5-6 of claim 47 in order to overcome this objection.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 28-30 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Calcote (US 6,355,063). Calcote anticipates the claim language where the radially expandable tubular body structure as claimed is the expanded PTFE graft (2) of Calcote, the string as claimed is the hollow tube (4), and the tube is exclusively wrapped about the outer surface. The graft of Calcote is inherently radially expandable to at least some extent because no material is perfectly rigid. Furthermore, expanded PTFE has fibrils and nodes that make it stretchable, and thus expandable, between the nodes;

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see Figures 1 to 5, column 2, lines 1-24, column 3, lines 6-15, column 3, line 53 to column 4, line 55 and column 5, lines 17-32.

Claims 28-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Buscemi et al (US 5,769,883). Buscemi meets the claim language where the expandable tubular body is the main body (11) of Buscemi, and the string as claimed is fiber (18) of Buscemi; see Figures 1 to 3, column 4, lines 8-56 and column 12, lines 7-46.

Regarding claim 31, spinning is considered to be a type of extrusion process; see column 4, lines 50-52.

Claims 33, 42, 44, and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Woodruff (US 4,160,467). Woodruff anticipates the claim language where the preamble is not needed for the claim body for completeness; see Figure 1 and column 3, lines 40-58. Therefore, Woodruff reads on the claim language as follows:

- the body structure as claimed is the hand loom (20) of Woodruff
- the support elements as claimed are transverse members (26, 28, 30, 32)
- the grooves as claimed are grooves (36)
- the string as claimed is ward thread (34).

Allowable Subject Matter

Claims 1, 3, 4, 8-11, 21-25, 27, 34-41, 43, 45, and 46 are objected to only and would be allowable if rewritten or given antecedent basis from the specification.

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In order to put the application in condition for allowance, the Examiner suggests canceling claims 28-32 and 47 and amending claim 33 to include one of the limitations of the otherwise allowable dependent claims 34-41, 43, and 45. Claims 1 and 33 must also be amended as suggested above, namely, including the language ---of said implantable prosthesis--- after "body structure", (1) on line 3 of claim 1, and (2) on line 5 of claim 33.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

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Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic
Primary Examiner
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